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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,302	12/04/2000	David R. Hansen	MBHB00-787	7605

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PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
343 STATE STREET
ROCHESTER, NY 14650-2201

EXAMINER

THOMPSON, JAMES A

ART UNIT PAPER NUMBER

2624

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/729,302

Applicant(s)

HANSEN, DAVID R.

Examiner

James A Thompson

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Response to Arguments

Applicant's arguments filed 07 April 2005 have been fully considered but they are not persuasive.

Regarding page 2, line 4 to page 3, line 14: Applicant argues that there is no motivation to combine Motoyama (US Patent 5,353,388) and Hanson (US Patent 5,956,736). On page 2, lines 23-25 of the present arguments, Applicant quotes the motivation given by Examiner on page 4, lines 1-4 of the previous office action, dated 04 February 2005. With respect, this quote is incomplete and the incompleteness of the quote leads to an erroneous conclusion. Further, on page 3, lines 5-8 of the present arguments, Applicant alleges that "the only rationale provided by the Examiner for combining the references consists of a listing of advantages that would result after the combination, but does not include any showing of where the advantages are disclosed in any of the cited references."

Examiner responds: Examiner has clearly shown in the section of said previous office action that has been incompletely quoted by Applicant on page 2, lines 23-25 of the present arguments that the motivation to combine Motoyama and Hanson is located on column 4, lines 34-39 of Hanson. Indeed, the full quote of the passage referred to by Applicant is:

"The motivation for doing so would have been to allow a user to modify the contents of the document and the manner in which said document is printed (column 4, lines 34-39 of Hanson)." [page 4, lines 1-4 of said previous office action]

The cited passage of Hanson specifically states:

"Each one of the objects in the collection of objects may be edited by way of a context sensitive object editor to customize the Web document. An object is selected by an input device and dragged to an object

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editor window, where the properties associated with the object are displayed and may be modified."

Therefore, the motivation is clearly given in Hanson and has been cited by Examiner.

Furthermore, even *arguendo* if the motivation was not cited in the references, Applicant is respectfully reminded that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In the case of Motoyama, a page description language document is taught. In Hanson, a hypertext markup language (HTML) document, HTML being a specific type of page description language, is taught. The mere use of a Graphical User Interface for the purposes of editing a document is trivial in the art and would have been trivial to one of ordinary skill in the art at the time of the invention. The motivation that one of ordinary skill in the art at the time of the invention would have to use a graphical user interface would clearly have been as taught by Hanson, namely to allow a user to modify the contents of the document and the manner in which said document is printed.

Regarding page 3, lines 15-27: Motoyama has clearly been demonstrated to teach "assigning group identifiers into the document to establish groups of pages in the document (figure 1a(110) and column 3, lines 49-54 of Motoyama); and instructing the computer to send one or more of the groups of pages of the document (column 10, lines 34-40 of Motoyama) to an output data

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stream for printing (column 11, lines 38-43 of Motoyama)" [page 3, lines 3-9 of said previous office action]. Hanson has clearly been demonstrated to teach "a GUI (figure 6C and column 8, lines 44-47 of Hanson) that is used to open, and thus receive, document data (column 10, lines 30-32 of Hanson); assign identifiers in the document (column 11, lines 48-54 of Hanson), and therefore create an amended document (column 11, lines 43-48 of Hanson); and instruct the computer to output the document data (column 13, lines 60-64 of Hanson)" [page 3, lines 18-24 of said previous office action]. By combination, Motoyama and Hanson fully teach the limitations argued by Applicant on page 3, lines 21-24 of the present arguments. This has been fully demonstrated on page 3, line 27 to page 4, line 1 of said previous office action which states: "At the time of the invention, it would have been obvious to a person of ordinary skill in the art to perform the steps of receiving, assigning and instructing, as taught by Motoyama, using a GUI and thus creating an amended document, as taught by Hanson."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A Thompson whose telephone number is 571-272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Thompson
Examiner
Art Unit 2624

JAT
13 April 2005



THOMAS D.
~~LEE~~ LEE
PRIMARY EXAMINER